REMARKS

The present amendment is in response to the Office action dated 30 May 2008, where the Examiner has rejected claims 1-7, 9-21 and 40-47. No claim amendments have been made. Accordingly, claims 1-7, 9-21 and 40-47 are pending in the present application with claims 1, 13 and 40 being the independent claims. Reconsideration and allowance of pending claims 1-7, 9-21 and 40-47 in view of the following remarks are respectfully requested.

A. 35 USC §102(e)

Claims 1-7, 9-21 and 40-47 stand rejected under section 102(e) as being anticipated by U.S. Publication No. 20020111865 ("Middleton") and also as being anticipated by US Patent No. 6,035,332 ("Ingrassia").

<u>Independent Claim 1</u>

Initially, Applicant points out that the 102 rejection of claim 1 set forth in the office action dated 30 May 2008 is nearly word for word identical to the 102 rejection set forth in the 18 October 2007 office action. The only substantive difference in these rejections (notwithstanding the recitation of Applicant's changed claim language) is the addition of the following words:

"Furthermore Middleton discloses a HTTP) protocol where Web pages are transferred between Web servers and clients (see., paragraph [0004], [0014], [0046]);"

The rest of the single paragraph rejection is the same, including the typographical errors (e.g., using the word "even" rather than "event"). One grammatical difference is that the phrase "markup must be came" in the 18 October 2007 office action was changed to "markup must be come" in the 30 May 2008 office action.

This one phrase difference in the explanation of the rejection is insufficient to adequately address the amendment made by Applicant to claim 1.

Specifically, claim 1 requires that the event tracking server receive an event signal from the client device and that the event signal include data that is descriptive of a user interaction with a content server. Middleton and Ingrassia disclose this much but do not go further.

Claim 1, however, further requires that the event signal is sent in response to an HTML element received by the client device from the content server. Middleton and Ingrassia, in contrast, monitor user activity with the applet that is executing on the client device but do not take action in response to HTML elements received from the content server. Thus, Middleton and Ingrassia do not disclose this step.

Still further, claim 1 requires that the event signal conforms to the HTTP protocol and that the event signal includes event definition data in the HTTP header <u>and</u> in the URL parameters of the event signal. Neither Middleton or Ingrassia disclose any format or protocol for the monitored activity that is sent by the applet executing on the client device to the activity server (Middleton) or synchronization server (Ingrassia). The references also do not disclose sending event definition data in the HTTP header and in the URL parameters of the event signal as required by claim 1. Accordingly, applicant believes that claim 1 is fully distinguished from Middleton and Ingrassia and respectfully requests a notice of allowance that includes claim 1 and its respective dependent claims.

Independent Claim 13

The examination of independent claim 13 is equally inadequate. The 30 May 2008 rejection of independent claim 13 based on Middleton is identical to the 18 October 2007 rejection with the exception of the following additional sentence:

"Furthermore Middleton discloses a HTTP protocol where Web pages are transferred between Web servers and clients (see., paragraph [0004], [0014], [0046])."

This one phrase difference in the explanation of the rejection is insufficient to adequately address the amendment made by Applicant to claim 13.

Specifically, claim 13 requires that the event tracking server receive a request from the network user and that the request includes a request to record event-tracking information. Additionally, claim 13 requires that the request be originally contained in a specially formatted Web page on the content server. Middleton and Ingrassia do not disclose that a request that gets sent to the event tracking server is originally included in a specially formatted Web page on the content server. The Middleton and Ingrassia

references are not directed toward web content but rather they are concerned with downloading an applet to the client device that executes on the client device in order to monitor user activity and report that activity to an activity server (Middleton) or synchronization server (Ingrassia).

Finally, claim 13 requires that the request that is received by the event-tracking server is sent in response to an HTML code element that is extracted from the specially formatted Web page. Middleton only discloses that at some point the applet sends the monitored user activity report to the activity server at an appropriate time, such as when the display of the web page is terminated. This does not disclose sending a request to the event-tracking server in response to an HTML code element extracted from the specially formatted Web page, as required by claim 13. Ingrassia also does not disclose this requirement. Ingrassia only discloses that the applet running on the client reports the activities to a synchronization server. Ingrassia does not disclose that the reporting is carried out responsive to an HTML code element that is extracted from the specially formatted Web page.

In contrast to claim 13, both Middleton and Ingrassia disclose applet based solutions for monitoring user activity and these applets necessarily run separate from the browser and in the Java virtual machine. These applets do not send their respective activity logs to a server in response to an HTML code element that is extracted from a specially formatted web page. Instead they send their respective activity logs to a server at a predetermined time, such as when the display of the web page is terminated. Accordingly, applicant believes that claim 13 is fully distinguished from Middleton and Ingrassia and respectfully requests a notice of allowance that includes claim 13 and its respective dependent claims.

Independent Claim 40

The rejection office action dated 30 May 2008 action fails to address the elements of claim 40 and instead lumps the 102 rejection of independent claim 40 together with the rejection of independent claim 1. This grouping of independent claims 1 and 40 into a single 102 rejection suggests that the Examiner may not fully

Serial No. 10/037,674
1 December 2008 Reply to
30 May 2008 Office Action

comprehend the claimed invention because these separate independent claims have different elements. However, what is clear from the 18 May 2008 rejection is that not every element of claim 40 was addressed in the 102 rejection that included claim 40. This is insufficient to demonstrate a *prima facie* case of anticipation.

The examiner has the initial burden of establishing a prima facie case of anticipation by pointing out where all of the claim limitations appear in a single reference. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). To anticipate a claim, the reference must teach each and every element of the claim. See, *MPEP* 2131. Additionally, for a claimed invention to be anticipated, all of the elements of the claim must be found in one reference. See *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). Furthermore, it is improper to reject a claim without considering and addressing all of the claim limitations because "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Based on the failure to establish a prima facie case of anticipation, Applicant therefore believes that claim 40 is presently in condition for allowance and a notice of allowance of claim 40 and its respective dependent claims is respectfully requested.

Furthermore, with respect to the analysis of independent claim 40 in view of Middleton and Ingrassia, the steps of independent claim 40 are not disclosed by these references standing alone or in combination the two references. Both Middleton and Ingrassia are applet references. Each relies on an applet that is downloaded to the client device and executed by the Java virtual machine. As the applet executes on the client device, it monitors the user activity and then sends a report to a server. (see Abstract of Middleton and Ingrassia).

Independent claim 40 distinguishes the applet based monitoring described by Middleton and Ingrassia. Specifically, claim 40 requires that the content server receive

an event from the client device, for example a request to include an item in a shopping cart. At this point, if this is the first request from the user, under Middleton and Ingrassia this first request does not get monitored because the applet has not yet been downloaded to the client and the applet is not yet running, so it cannot monitor this first event. In further contrast, Ingrassia requires that the first request be responded to by the content server in order to cause the client device to make a second request to download the applet. (Fig. 3, element 4).

Next, claim 40 requires that the content server dynamically generate an event definition section that is associated with the event that just occurred such that the event definition section includes an event identifier and event definition data regarding the event that just occurred. These actions take place at the content server and no such content server actions are disclosed by Middleton or Ingrassia.

Claim 40 also requires that the content server retrieve web page content that is responsive to the event and then insert the dynamically generated event definition section into the web page content and returning the web page content with the event definition section to the client device.

Middleton and Ingrassia fail to disclose any such content server actions because their disclosures are only directed toward applet based user monitoring and the applets execute at the user station within the context of a Java virtual machine that is associated with the browser.

Furthermore, claim 40 requires that the event tracking server receive an event signal from the client device and that the event signal includes the event definition section that was dynamically generated by the content server. Middleton and Ingrassia only disclose that a log of monitored user activity is sent to the activity server (Middleton) or synchronization server (Ingrassia). Neither reference discloses that data regarding an event that just occurred is dynamically generated by the content server, sent to the client device, and then sent to the event-tracking server, as required by claim 40.

Serial No. 10/037,674
1 December 2008 Reply to
30 May 2008 Office Action

Still further, claim 40 requires that the event-tracking server parse the event signal to obtain the event identifier from the event definition section and then get an instruction from a memory of the event-tracking server by using the event identifier. Middleton and Ingrassia do not disclose these event-tracking server actions because both references are focused on the applets that execute on the client device.

Accordingly, Applicant believes that amended claim 40 is clearly distinguished from Middleton and Ingrassia and respectfully requests a notice of allowance including at least claim 40 and its dependent claims.

New dependent claims 41-47 have been added to further refine and limit the scope of independent claim 40. Claims 41-45 are directed toward the details of the event definition section, which is dynamically created by the content server and sent to the client device. Claim 46 is directed toward the event-tracking server and the requested image file stored on the event-tracking server and claim 47 is directed toward the event-tracking server the action it takes when receiving a request for a specific image file. Middleton and Ingrassia do not disclose these additional steps set forth in dependent claims 41-47.

B. Status of Next Office Action

Because the 18 May 2008 office action failed to adequately address all of the elements in the independent claims that were rejected and therefore failed to establish a *prima facie* case of anticipation, Applicant requests that the next office action be made non-final unless it includes a notice of allowance for the pending independent claims. The 18 May 2008 office action similarly failed to address all of the steps in the various dependent claims that were also rejected and therefore failed to establish a *prima facie* case of anticipation for the dependent claims. For this reason too Applicant requests the status of the next office action be made non-final unless it includes a notice of allowance.

Serial No. 10/037,674
1 December 2008 Reply to
30 May 2008 Office Action

CONCLUSION

For all the foregoing reasons, allowance of pending claims 1-7, 9-21 and 40-47 is respectfully requested. If the Examiner believes that a telephone conversation may be useful in advancing prosecution, the Examiner is invited to contact the undersigned at the number listed below. If necessary, applicant requests to extend the period for filing this reply pursuant to 37 CFR 1.136(a) and authorizes the Director to charge any additional fee(s) or any underpayment of fee(s) or credit any overpayment(s) to Procopio Deposit Account No. 50-2075.

Respectfully submitted,

Dated: December 1, 2008

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